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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,924	03/31/2004	David Benjamin Auerbach	24207-10118	6346

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EXAMINER

LEWIS, ALICIA M

ART UNIT PAPER NUMBER

2164

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,924

Applicant(s)

AUERBACH ET AL.

Examiner

Alicia M. Lewis

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on October 27, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "108" has been used to designate both memory and computer-readable medium (spec, paragraph 11). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: element 114. Corrected drawing sheets in compliance with 37 CFR

1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19-35 are not limited to tangible embodiments. In view of applicant's disclosure, specification page 5, paragraph 11, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., floppy disk, DVD, CD-ROM) and intangible embodiments (e.g. transmission devices). Furthermore, the specification states that the computer-readable media are not limited to any of the listed media. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 12-15, 17-20, 30-33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Belfiore et al. (US Patent 6,009,459) ('Belfiore').

With respect to claims 1 and 19, Belfiore teaches:

receiving a term in an input field (step 60 in Figure 4, column 5 lines 13-14);

searching an article index for an article identifier associated with the term, the article identifier associated with an article (column 5 lines 14-17, 40-43, 60-67, column 6 lines 1, 30-55);

receiving the article identifier (column 5 lines 47-48, column 6 lines 53-58); and

causing the article identifier to be output in a transient menu associated with the input field (column 8 lines 1-11).

With respect to claims 2 and 20, Belfiore teaches wherein searching the article index comprises generating a user-context-dependent query (column 5 line 66 – column 6 line 1).

With respect to claims 12 and 30, Belfiore teaches wherein the input field comprises an address bar (element 84 in Figure 5, column 5 lines 11-13).

With respect to claims 13 and 31, Belfiore teaches wherein the input field comprises a query-input field (element 84 in Figure 5, column 5 lines 11-13, column 4 lines 30-35).

Belfiore teaches that the address box may be used to enter either URLs or search terms.

With respect to claims 14 and 32, Belfiore teaches wherein the input field comprises an article-integrated input field (element 84 in Figure 5, column 5 lines 11-13).

In paragraph 59 of the specification, applicant discloses that an article-integrated field may be a text box, and Belfiore teaches that his address box is a text box.

With respect to claims 15 and 33, Belfiore teaches wherein the article comprises a web page (column 4 lines 3-7).

With respect to claims 17 and 35, Belfiore teaches further comprising searching a second article index for a second article identifier associated with the term, the second article identifier associated with a second article, and causing the second article identifier to be output in the transient menu (column 8 lines 1-11).

Belfiore teaches that more than one search result (or article identifier) may be returned in the menu.

With respect to claim 18, Belfiore teaches:

receiving a term in a network browser address bar (step 60 in Figure 4, column 5 lines 13-14);

searching an index with a user-context dependent search query for a URL associated with the term, the URL associated with a web page associated with the term (column 5 line 66 – column 6 line 1, column 6 lines 30-55);

receiving the URL (column 6 lines 55-57);

causing the URL to be displayed in a transient menu near the network address bar (Figures 11B and 13B, column 8 lines 1-11);

receiving a select indication for the URL (column 8 lines 20-22); and

displaying a web page associated with the URL (column 8 lines 22-27).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-8 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belfiore et al. (US Patent 6,009,459) ('Belfiore') in view of Konig et al. (US Patent 6,981,040) ('Konig').

With respect to claims 3 and 21, Belfiore teaches claims 2 and 20.

Belfiore does not teach wherein the user context is based, at least in part, on a user action history comprising a plurality of user actions.

Konig teaches automatic, personalized online information and product services (see abstract), in which he teaches wherein the user context is based, at least in part, on a user action history comprising a plurality of user actions (column 17 lines 13-40).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Belfiore by the teaches of Konig because wherein the user context is based, at least in part, on a user action history comprising a plurality of user actions would enable transparent monitoring of user interactions to create a user model, which in turn could be used to provide a user with personalized information services, such as ranking of search results based on user interests (Konig, column 4 lines 22-34).

With respect to claims 4 and 22, Belfiore as modified teaches wherein each of said user actions comprises a date/time parameter (Konig, Figures 4A-4D).

With respect to claims 5 and 23, Belfiore as modified teaches wherein causing the article identifier to be output in a transient menu associated with the input field comprises outputting the article identifier in accordance with a user preference (Konig, column 17 lines 41-47, column 27 lines 42-48).

With respect to claims 6 and 24, Belfiore as modified teaches further comprising receiving the user preference (Konig, column 17 lines 41-47).

With respect to claims 7 and 25, Belfiore as modified teaches further comprising determining the user preference based, at least in part, on a user action history comprising a plurality of user actions (Konig, column 17 lines 13-40).

With respect to claims 8 and 26, Belfiore as modified teaches further comprising determining the user preference based, at least in part, on a system analysis (column 5 lines 50-52).

9. Claims 9-11 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belfiore et al. (US Patent 6,009,459) ('Belfiore') in view of Sommerer et al. (US Patent Application Publication 2004/0003351 A1) ('Sommerer').

With respect to claims 9 and 27, Belfiore teaches a transient menu near the input field (Figure 13B, column 8 lines 1-11).

Belfiore does not explicitly disclose that the menu is a drop-down menu.

Sommerer teaches navigating a resource browser session (see abstract) in which he teaches a drop-down menu near an input field (Figure 3, paragraph 57).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Belfiore by the teaching of Sommerer because a drop-down menu near an input field would enable a browser session navigation tool that allows users to browse previously viewed resource pages, and more specifically allow users to search the record of their browsing experience during the browsing session (Sommerer, abstract); thus providing more search capabilities to Belfiore's invention.

With respect to claims 10 and 28, Belfiore as modified teaches wherein the transient menu comprises a pop-up menu near the input field (Sommerer, paragraph 29, 51 and 76).

With respect to claims 11 and 29, Belfiore as modified teaches wherein the transient menu comprises a slide-out menu near the input field (Sommerer, paragraph 29).

10. Claims 16 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belfiore et al. (US Patent 6,009,459) ('Belfiore') in view of Dumais et al. (US Patent Application Publication 2004/0267730 A1) ('Dumais').

With respect to claims 16 and 34, Belfiore teaches claims 1 and 19.

Belfiore does not teach wherein the article comprises an article stored on a client device.

Dumais teaches systems and methods for performing background queries from content and activity (see abstract), in which he teaches wherein the article comprises an article stored on a client device (paragraph 34).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Belfiore by the teaching of Dumais because wherein the article comprises an article stored on a client device would enable the creation of a content index of accessed data items, comprising information from local data locations as well as web information. This context index, in turn, could be used in the generation of queries to find useful information.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Lewis whose telephone number is 571-272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2164

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alicia Lewis
October 12, 2006



SAM RIMELL
PRIMARY EXAMINER